

## **COMMENTS**

The enclosed is responsive to the Examiner's Office Action mailed on may 8, 2003. At the time the Examiner mailed the Office Action claims 1 through 12 and 60 through 69 were pending. In response, the Applicant has: 1) added new claims 90 through 96; and, 2) amended claim 60. As such, claims 1 through 12, 60 through 69 and 90 through 96 are currently pending. The Applicant respectfully requests reconsideration of the present application and the allowance of claims 1-12, 60-69, and 90-96.

### **The Cyrus Reference**

Independent claim 1 stands rejected under 35 USC 102(e) in light of US Patent No. 5,889,866 (hereinafter, "Cyrus"). Independent claim 1 of the present application recites (emphasis added):

1. A smart card comprising:  
an interface with a smart card reader;  
first circuitry configured to receive a first enable signal from a smart card enabler; and  
second circuitry coupled with the interface and first circuitry and configured to allow the smart card to function with the smart card reader based on the first enable signal.

The Applicant respectfully submits that Cyrus manifestly fails to disclose both the first and second circuitries as claimed by the Applicant's claim 1. Specifically, Figures 4 and 5 of Cyrus and their corresponding discussion (See, Cyrus, Col. 7, line 26 – Col. 8, line 33) respectively disclose a configuration register (54) and a configuration circuitry (55) that each receive an enable signal (50). Therefore,

viewing the Cyrus reference in a light that is most favorable to the Examiner's position, it is clear the both the configuration register (54) and the configuration circuitry (55) must be regarded as matter that attempts to cover "the first circuitry" element of the Applicant's claims (because the Applicant's first circuitry is "configured to receive a first enable signal").

With the configuration register (54) and the configuration circuitry (55) being regarded as directed to the Applicant's "first circuitry", it is very clear to the Applicant that nothing further is disclosed in Cyrus that is sufficient to cover the Applicant's claimed "second circuitry". Specifically, Cyrus simply fails to disclose any other circuitry that is "coupled with [an interface with a smart card reader] and [the] first circuitry". As such, Cyrus simply fails to cover each and every element of the Applicant's independent claim 1. Should the Examiner disagree, the Applicant respectfully requests that the Examiner point out in a subsequent Office Action specifically where in Cyrus the Applicant's second circuitry is found.

### **The Dethloff Reference**

Independent claims 1 and 60 stand rejected under 35 USC 102(e) in light of US Patent No. 6,047,888 (hereinafter, "Dethloff"). Independent claim 1 of the present application recites (emphasis added):

1. A smart card comprising:  
an interface with a smart card reader;  
first circuitry configured to receive a first enable signal from a smart card enabler; and  
second circuitry coupled with the interface and first circuitry and configured to allow the smart card to function with the smart card reader based on the first enable signal.

and independent claim 60 of the present application recites (emphasis added):

60. A smart card, comprising:

- a) a first interface through which communications with a smart card enabler are transported;
- b) a second interface through which communications with a smart card reader are transported;
- c) memory to store an identification key, a transaction key and a transaction value; and
- d) a processor to:
  - 1) send said identification key to said smart card enabler through said first interface;
  - 2) send said transaction key to said smart card enabler through said first interface as a consequence of said smart card receiving a first enable signal from said smart card enabler, said first enable signal sent in response to said sending of said identification key;
  - 3) send said transaction value to said smart card reader through said second interface in order to entertain a transaction, said transaction value being sent as a consequence of said smart card receiving a second enable signal from said smart card enabler, said second enable signal sent in response to said sending of said transaction key.

From the emphasized language above it is clear that each of the Applicant's claims 1 and 60 claim a smart card that receives an enable signal from a smart card enabler. By contrast, viewing Dethloff in its most favorable light with respect to the Examiner's position (i.e., regarding data medium (20) as a smart card) the Applicant respectfully submits that Dethloff fails to disclose a smart card that receives an enable signal. Specifically, the only portions of Dethloff cited by the Examiner that seem to relate to the enablement of a smart card are found at Col. 10, line 65 through Col. 11, line 17; and, Col. 15, lines 5 – 14.

Col. 10, line 65 through Col. 11, line 17 of Dethloff discloses only that a "secret number" (e.g., a PIN) is passed from a terminal to a data medium (20). ("a secret number can be transferred from a memory 7a in terminal 1 to the data medium 20" Dethloff Col. 10, lines 66-67) and that the data medium (by way of an on board comparator 21a), in response to the reception of the secret number, actually determines for itself whether or not it is to be enabled ("[t]he comparator

21a subsequently checks whether or not the two secret numbers [are equal] . . . only if this is the case would the control unit be enabled" Dethloff Col. 11, lines 9-13). Because Col. 10, line 65 through Col. 11, line 17 of Dethloff only discloses the reception by a data medium/smart card of a "secret number" coupled with the data medium/smart card deciding for itself whether or not it is to be enabled, Dethloff simply fails to disclose the reception of an enable signal by a data medium/smart card.

Col. 15, lines 5 – 14 of Dethloff discloses that vendor identifiers are used to enable transactions; however, nothing is said specifically with regard to an "enable signal". As such, Col. 15, lines 5 – 14 of Dethloff also fails to disclose the reception of an enable signal by a data medium/smart card.

As such, Dethloff fails to anticipate Applicant's claims 1 and 60.

### **Conclusion**

Because the Applicant has demonstrated that the prior art references cited by the Examiner fail to render the Applicant's independent claims unpatentable, the Applicant respectfully submits that all of the Applicant's pending claims are patentable and respectfully requests the allowance of same.

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Robert O'Rourke at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date:

10/8/03

  
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